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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,917	02/20/2002	Frank Becher	R00360US (#90568)	3850

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EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,917

Applicant(s)

BECHER, FRANK

Examiner

Hai C Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### Claim 25:

- Claim 25 recites the following limitations “applying at least two overlying pigmented layers (emphasis added)” (line 3) and “to visualize the at least two underlying pigmented color layers (emphasis added)” (line 5), which appear to be directly contradicting.

#### Claim 26:

- Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for being incomplete. Claim 26 sets out to perform a toner-free inscription of a sheet-like adhesive system, but fails to claim any thing related to such performance. In other words, claim 26 fails to distinguish itself from any other device for inscribing a sheet-like adhesive system in either toner-free or with involving toner manner. Therefore, it is unclear how with the recited claimed limitations, the device would create a toner-free inscription of the sheet-like adhesive system.

Claim 28:

- Similarly, claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for being incomplete since claim 28 fails to distinguish itself from any other device for inscribing a sheet-like adhesive system in either toner-free or with involving toner manner;
- The limitation "data generated by other production steps (emphasis added)" at line 5 is unclear in that it is not known whether the other production steps are part of the function of the claimed device in performing the inscription, and that it is unclear how such production steps would be conducted.

Claim 27 is dependent from claim 26, and is therefore indefinite.

Appropriate correction is required.

***Claim Objections***

3. Claim 1 is objected to because of the following informalities:
    - Line 11, "the device" should read --the sheet-like active agent-containing therapeutic system--, since the device would refer to the laser beam emission device, which would not make sense.
- Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi et al. (U.S. 5,831,661) in view of Clement (WO 97/44196) in view of Jack (U.S. 5,151,572).

Clement discloses a device and method for forming visible images by laser radiation with the energy as well as the depth or penetration of the laser beam being carefully programmed and/or adjusted such that only selective overlying layers are ablated (toner-free marking) at the depth of the selected layer without affecting further layers, the overlying layers being colored layers so as to selectively reveal different layers.

However, Clement fails to teach the programmable central control unit including a keyboard and accepting transferred data.

Jack discloses a method and apparatus for making a stencil for etching glass using a laser beam to cut through the thin stencil template from a label, the apparatus including a host computer with a user input device, e.g. keyboard, and a laser interface card such that the parameters of the laser beam are controlled based on a user interface control software stored in the host computer.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the user interface control software as taught by Jack in the device of Clement. The motivation for doing so would have been

to provide a consistent, repeatable process of inscribing information on the label with preciseness.

It is noted that the intended use statement in the preamble of each of claims 26-28, e.g., "toner-free inscription" and "sheet-like adhesive system" does neither imply nor recite any specific structure or the claimed device, and less how the device would treat the sheet-like adhesive system. The device as claimed can be applied to a variety of instance for inscribing information on a regular workpiece. Therefore, the above subject matters are not given patentable weight (see MPEP 2111.02).

6. Claims 13, 15-22, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi et al. (U.S. 5,831,661) in view of Clement and Applicant's Acknowledged prior Art (referred hereinafter as AAPA).

Tabuchi et al. discloses a device and method for toner-free inscription, e.g., by ablation, of a sheet-like adhesive system comprising placing the sheet-like adhesive system with the adhesive side facing a support position (peelable substrate 4), guiding the laser emission (laser beam 6) onto the sheet-like adhesive system, and controlling the intensity and penetration depth of the laser beam according to the material properties of the sheet-like adhesive system in such a way that the laser beam does not penetrate far enough the sheet-like adhesive system and preventing a detrimental influence on the adhesive (the laser beam is controlled to ablate only the colored layer 2 wherever it is located with respect to other layers within the sheet-like adhesive system such that the laser beam does not penetrate into the adhesive layer [see Figs. 1, 2, and

4] nor does it affect the underlying adhesive layer by the rising temperature during the ablation of the colored layer 2).

However, Tabuchi et al. fails to teach the guidance of the laser beam being performed by a program of a manually operable central control unit, the adhesive containing active therapeutic agent (claims 13, 22), the active agent-containing therapeutic system being in the form of a plaster (claim 15).

Clement discloses a device and method for forming visible images by laser radiation with the energy as well as the depth or penetration of the laser beam being carefully programmed and/or adjusted such that only selective overlying layers are ablated (toner-free marking) at the depth of the selected layer without affecting further layers, the overlying layers being colored layers so as to selectively reveal different layers.

On the other hand, AAPA suggests the needs for sheet-like active agent-containing therapeutic system, which includes plaster, to have useful information inscribed onto the material layer.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Tabuchi et al. to include the programmable control unit as taught by Clement to inscribe information onto the sheet-like adhesive system containing therapeutic active agent as suggested by AAPA. The motivation for doing so would have been to provide the flexibility and automation to the laser-inscribing device to controllably perform the ablation of the desired layer within the sheet-like adhesive system.

Tabuchi et al. further teaches that the underlying colored layer (2) can have a multiple layer construction,

7. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi et al. in view of Clement and AAPA, as applied to claims 13, 22 above, and further in view of Jack.

The modified device of Tabuchi et al. discloses all the basic limitations of the claimed invention except for the programmable central control unit including a keyboard and accepting transferred data.

However, Jack discloses a method and apparatus for making a stencil for etching glass using a laser beam to cut through the thin stencil template from a label, the apparatus including a host computer with a user input device, e.g. keyboard, and a laser interface card such that the parameters of the laser beam are controlled based on a user interface control software stored in the host computer.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the user interface control software as taught by Jack in the modified device of Tabuchi et al. The motivation for doing so would have been to provide a consistent, repeatable process of inscribing information on the label with preciseness.



***Response to Arguments***

8. Applicant's arguments with respect to claims 13, 15-28 have been considered but are moot in view of the new grounds of rejection presented in this Office action.

9. With regard to Applicant's arguments that "Clement et al. does not disclose any dimensions for a suitable thickness of the layers having different hues or reflection densities", the examiner notes that the above subject matter related to the dimensions for a suitable thickness of the layers is not claimed either, and therefore does not form a basis for an argument of non-disclosure by the prior art. Moreover, contrary to Applicant's assertion that "Clement et al. does not indicate the toner-free laser inscription", Clement et al. does however teach the use of the laser radiation for selectively ablating (toner-free inscription) of material from specific layers in a predetermined pattern (page 2, lines 6-11).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432.

Art Unit: 2861

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM  
PRIMARY EXAMINER  
November 13, 2003